

sion to a jury. As a matter of law, I find that defendants have not used plaintiff's ideas and that plaintiff thus has no viable contract claim. See *Weitzenkorn*, supra.

III. Conclusion

Pursuant to Rule 56 of the Federal Rules of Civil Procedure, defendants' motion for summary judgment is granted.

So ordered.

Lindquist, Examiner-in-Chief.

This appeal is from the final rejection of claims 2 through 4 and 6 through 11, all the claims in this application.

The invention pertains to a telephoto lens assembly. In view of the issue presented in this appeal, we consider it unnecessary to reproduce a representative claim.

Patents cited by the examiner are as follows.

Momiyama	4,045,128	Aug. 30, 1977
Ogino	4,126,378	Nov. 21, 1978
		(Filed Mar. 21, 1977)

All the claims at bar "stand rejected under 35 U.S.C. 103 as unpatentable over the prior invention of Ogino in view of Momiyama."

The appellants do not contend that it would not have been obvious to combine the subject matter of Ogino and Momiyama. Nor do the appellants deny that the combination results in that which is claimed.

The appellants claim the benefit of the filing date of their corresponding Japanese application under the provisions of 35 U.S.C. § 119. Hence, the effective filing date of the present application is March 4, 1977. Ogino was filed in this country on March 21, 1977. Patentee Ogino is a co-inventor in this application. Both inventions were made in Japan. The patent to Ogino and the present application are commonly assigned. Counsel is the same in both cases.

Counsel in this country admits receipt of the initial translation of the Ogino application before March 4, 1977, the effective filing date of this case. Based upon this admission, the examiner is of the opinion that the invention of Ogino was made in this country by another who had not abandoned, suppressed or concealed it before the appellants' invention on March 4, 1977. Receipt of the initial translation is said by the examiner to be evidence of conception and the requisite due diligence is said to have been exercised to establish that Ogino made his invention in this country before the appellants' effective filing date.

The appellants concede that the patent to Ogino is the prior invention of another but deny that the patent is prior art to them under any provision of section 102.

Opinion

The appellants readily concede that Ogino is the prior invention of another that, under the circumstances of this case, must have been known to the appellants before their effective filing date. The most relevant consideration is that Ogino is a co-inventor in this case. This makes the invention of Ogino "prior art" to

Patent and Trademark Office Board of Appeals

Ex Parte Hachiken and Ogino

Opinion dated July 10, 1984

PATENTS

1. Patentability — Anticipation — Patent applications (§51.219)

Invention of one coinventor, initial translation of whose application was received in U.S. before effective filing date of application for patent on coinvention, is prior art with respect to coinventors' application, even though it was not filed until after coinventors' effective filing date.

Particular patents — Telephoto Lens System

Hachiken and Ogino, Telephoto Lens System, rejection of claims 2 through 4, and 6 through 11 affirmed.

Appeal from Art Unit 211.

Application for patent of Ryuzo Hachiken and Shuji Ogino, Serial No. 882,416, filed Mar. 1, 1978. From decision rejecting claims 2 through 4, and 6 through 11, applicants appeal (Appeal No. 492-12). Affirmed.

Joseph W. Price, Tustin, Calif., for appellants.

Before Henon, Spencer, and Lindquist, Examiners-in-Chief.

the appellants for any purpose including evidence of obviousness. In re Fout, 675 F.2d 297, 213 USPQ 532 (CCPA 1982); In re Nomiya, 509 F.2d 566, 184 USPQ 607 (CCPA 1975); In re Hellsund, 59 CCPA 1382, 474 F.2d 1307, 177 USPQ 170 (1973). A basis need not be found in section 102 for its use as prior art. In re Fout, supra; In re Nomiya, supra. That the prior invention of Ogino may be prior art to just the appellants, rather than the public in general, is of no consequence. In re Fout, supra; In re Nomiya, supra. Nor does it matter that the Ogino invention was made in Japan and known to the appellants in Japan. In re Nomiya, supra. For this reason alone we would sustain the rejection of the claims at bar.

[1] However, we also agree with the examiner's position that the *prior invention* of Ogino is available as "prior art" to the appellants under 35 U.S.C. § 102(g) by virtue of its admitted introduction into this country prior to the effective filing date of this application. Evidence of prior invention by another in this country before the effective filing date of the present application under section 102(g) may be used as evidence of obviousness. In re Bass, 59 CCPA 1342, 474 F.2d 1276, 177 USPQ 178 (1973). The date a draft application originating in a foreign country is introduced into this country by way of counsel may be taken as the date of conception of the invention in this country. In re Mulder, 716 F.2d 1542, 219 USPQ 189 (Fed. Cir. 1983); *Cleaver v. Kooi*, 190 USPQ 188 (Bd. Pat. Int. 1974); *General Talking Pictures Corp. v. American Tri-Ergon Corp.*, 96 F.2d 800, 36 USPQ 428 (3rd Cir. 1938). The examiner has alleged that the requisite due diligence was exercised, and the appellants do not contend otherwise.

Section 104 pertains to events or activities in a foreign country; the activity relied on by the examiner occurred in this country. Therefore, the appellants' arguments with respect to section 104 are not germane. In re Hilmer, 53 CCPA 1288, 359 F.2d 859, 149 USPQ 480 (1966), which was cited by the appel-

lants, is easily distinguished in that the examiner is not relying on Ogino as of its foreign filing date. The examiner's reliance on acts in *this country* does not violate the policy enunciated in Hilmer precluding the use of knowledge and acts in a foreign country for patent defeating purposes.

The appellants maintain at page 12 of the main brief that the receipt by counsel of the Ogino application establishes a date of conception and that the invention was not "completed" until it was actually filed in this country which was subsequent to their effective filing date. Completion of a prior invention can be shown by either a prior reduction to practice, which may be constructive upon the filing of a patent application, or a prior conception coupled with the requisite due diligence to a subsequent reduction to practice. The latter completion of the invention is applicable here. While we do not disagree with the appellants' assertion at page 14 of the main brief that both conception and reduction to practice are necessary for completion of the invention, *Kawai v. Metlesies*, 480 F.2d 880, 178 USPQ 158 (CCPA 1973) does not appear to us to stand for that proposition.

Finally, the appellants are of the opinion that In re McKellin, 529 F.2d 1324, 188 USPQ 428 (CCPA 1976) is dispositive of the issue in this appeal. We disagree. In McKellin, the winning party of an interference prevailed because of an earlier foreign priority date, and, therefore, the lost counts were held not to be "prior art" under any of the provisions of section 102. Here, the examiner is not relying on the foreign filing date of Ogino but, rather, on the date the invention was introduced in this country.

Accordingly, the rejection of claims 2 through 4 and 6 through 11 under 35 U.S.C. § 103 is affirmed.

Affirmed.
